

REMARKS

The Application has been reviewed in light of the Office Action mailed February 24, 2004. At the time of the Office Action, Claims 5-17, 35-40, 42, 47, and 55-69 were pending in this Application. Applicant previously canceled Claims 1-4, 18-34, 41, 43-46, and 48-54 without prejudice or disclaimer. Claims 5-17, 35-40, and 42 stand rejected under 35 U.S.C. §103(a). Applicant appreciates Examiner's allowance of Claims 47, 55-67, and 69. Claim 68 stands objected to for informalities. Applicant has amended Claims 5 and 68. New Claims 70-72 have been added. No new matter is presented by these amendments. Applicant respectfully requests reconsideration and favorable action in this case.

Claim Objections

Claim 68 stands objected to by the Examiner for informalities. Applicant appreciates the Examiner careful review and has amended the Claim as required.

Claim Rejections Under 35 U.S.C. §103

Claims 5-17, 35-40, and 42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 4,474,763 issued to Lubowe ("Lubowe") in view of foreign patent publication WO 96/01617 filed by Li et al. (hereinafter "Li").

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Claim 5, as amended, recites a method comprising, among other steps, "applying a formulation comprising isolated nucleic acids having one or more R-group substitutions provided after isolation."

Applicant respectfully submits that the cited references fail to disclose every element of Applicant's invention. Further, there is no motivation, suggestion or teaching to combine Lubowe or Li. Lubowe or Li, alone or in combination, fail to teach a method comprising "applying a formulation comprising isolated nucleic acids having one or more R-group substitutions provided after isolation" as recited by amended Claim 5. Applicant further submits that Li does not teach or suggest modification of isolated nucleic acid to provide R-groups. Modification of isolated nucleic acid provides improvements over naturally occurring DNA because modification allows regulation of the absorbance spectrum (see Application, Page 6, Lines 16-22). The cited references fail to disclose the recited limitations and cannot render obvious amended Claim 5.

Given that Claims 6-17, 35-40, and 42 depend from allowable Claim 5, Applicant respectfully submits that Claims 6-17, 35-40, and 42 are allowable. As such, Applicant respectfully requests that the Examiner withdraw the rejections and allow Claims 5-17, 35-40, and 42.

Allowable Subject Matter

Claims 47, 55-67 and 69 are allowed.

Information Disclosure Statement

Applicant would like to bring to the Examiner's attention that Applicant filed an Information Disclosure Statement on February 12, 2004. Applicant respectfully requests that this Information Disclosure Statement be considered and cited in the examination of the above-referenced Application. Applicant attaches a copy of the Information Disclosure Statement and PTO Form 1449 filed February 12, 2004 for the Examiner's convenience and a copy of the postcard receipt evidencing receipt by the Patent Office.

CONCLUSION

In light of the above amendments and remarks Applicant respectfully submits that the Application is now in condition for allowance and early notice of the same is earnestly solicited. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this Application, the Examiner is invited to contact the attorney of record by telephone or facsimile.

A check in the amount of \$55.00 is enclosed for the One Month Petition for Extension of Time Fee. The Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0383 of Baker Botts L.L.P. in order to effectuate this filing.

Respectfully submitted,

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